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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,646	12/12/2003	Reinhard Ebner	PF403D2	9581
22195	7590	10/24/2006	EXAMINER	
HUMAN GENOME SCIENCES INC. INTELLECTUAL PROPERTY DEPT. 14200 SHADY GROVE ROAD ROCKVILLE, MD 20850			HADDAD, MAHER M	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,646

Applicant(s)

EBNER ET AL.

Examiner

Maher M. Haddad

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-48 is/are pending in the application.
- 4a) Of the above claim(s) 38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-35, 37 and 44-48 is/are allowed.
- 6) ☒ Claim(s) 36 and 39-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

RESPONSE TO APPLICANT'S AMENDMENT

1. Applicant's amendment, filed 10/10/06, is acknowledged.
2. Claims 26-48 are pending.
3. Claim 38 stands withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention.
4. Claims 26-37 and 39-48 are under examination as they read on an isolated antibody or fragment thereof that specifically binds to an Ependymin polypeptide of SEQ ID NO: 2.
5. Regarding Applicants request for rejoinder of claim 38, pursuant to MPEP 821.04, however, it is until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.
6. In view of the amendment filed on 10/10/06, only the following rejection are remained.
7. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
8. Claims 36 and 39-43 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter rejection.

The phrase "an isolated cell that produces the antibody or fragment thereof" claimed in claim 36"; the phrase "at least 30 contiguous amino acid residues of SEQ ID NO: 2 in length" claimed in claim 39 (a and c) and the phrase "at least 50 contiguous amino acid residues of SEQ ID NO: 2 in length" claimed in claim 39(b and d) represent a departure from the specification and the claims as originally filed for the same reasons set forth in the previous Office Action mailed 7/7/06.

Applicant's arguments, filed 10/10/06, have been fully considered, but have not been found convincing.

Applicant traverses the rejection on the ground that methods of producing antibodies from isolated cells were well-known in the art at the time of filing.

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However, knowledge in the art is not the standard for the addition of new limitations to the disclosure as filed. It is noted that entitlement to a filing date does not extend to subject matter which is not disclosed, but would be well-known over what is expressly disclosed.

Applicant is creating a new genus of cells that produce the antibody or the fragment thereof. A subgenus is not necessarily implicitly described by a genus encompassing it and a species upon which it reads, see *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972).

Applicant further argues that the at least 30/50 contiguous amino acid residues of SEQ ID NO:2 in length is clearly supported in the specification in context for epitope-bearing portions of an Ependymin polypeptide. Applicant submits that the specification clearly contemplates that polypeptides of the invention include portions that are at least 30 or 50 amino acids of SEQ ID NO: 2 (page 46, ¶127).

However, the specification on page 46, ¶127 discloses such portion in terms of percentage identity of the polypeptide rather than in the context for epitope-bearing portions of Ependymin polypeptide.

Applicant further points to the specification at ¶ 135-139 for support for such polypeptide being at least 30 amino acids in length.

Contrary to Applicant assertions, the Examiner is unable to find the support in the specification.

Finally, Applicant argues that one of skill in the art would clearly be able to recognize each and every fragment encompassed by the claims at issue.

However, obviousness is not the standard for the addition of new limitations to the disclosure as filed. It is noted that entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. Lockwood v. American Airlines Inc., 41 USPQ2d 1961 (Fed. Cir. 1977).

9. Claims 26-35, 37 and 44-48 are allowable.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maher Haddad whose telephone number is (571) 272-0845. The examiner can normally be reached Monday through Friday from 7:30 am to 4:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 12, 2006


Maher Haddad, Ph.D.
Primary Examiner
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